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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/824,086	04/02/2001	Tony Albrecht	P01,0121	9330
26574	7590	10/01/2004	EXAMINER LEUNG, QUYEN PHAN	
SCHIFF HARDIN, LLP PATENT DEPARTMENT 6600 SEARS TOWER CHICAGO, IL 60606-6473			ART UNIT 2828	PAPER NUMBER

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/824,086

Applicant(s)

ALBRECHT ET AL.

Examiner

Quyen P. Leung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. In response to applicant's amendment filed 7/16/2004, claims 1, 3, 4 have been amended and claims 26-29 canceled. Claims 1-25 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed 7/16/2004 have been fully considered but they are not persuasive. Applicant made the following arguments:

- a. "The present application thus relies on a priority date prior to the filing date of the cited Kinoshita reference. Applicants assert that the subject matter of the May 30, 2000, priority application predates the Kinoshita application and so the reference should be removed as a reference against this application."
- b. "It should be emphasized at this point that according to claim 1 of the present application the pump radiation source and the radiation generating quantum well structure are epitaxially grown on a common substrate, and not merely placed on any common carrier."

3. In response to **a** above, Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

4. In response to **b** above, Examiner asserts that the secondary reference Kinoshita teaches pump radiation source (30) and the radiation generating quantum well structure (10) are epitaxially grown on a common substrate (1), and not merely placed on any

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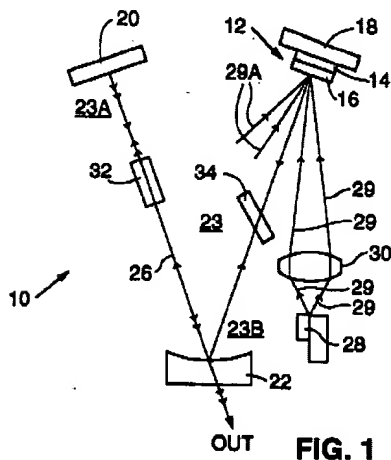
common carrier. See Kinoshita's figures 1A, 1B below clearly showing the epitaxially grown structures on a common substrate.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caprara et al (5,991,318) in view of Kinoshita (6,535,537). Caprara et al discloses the claimed invention except for the pump radiation source (28) being on the common substrate



[57]

#### **ABSTRACT**

An intracavity, frequency-doubled, external-cavity, optically-pumped semiconductor laser in accordance with the present invention includes a monolithic surface-emitting semiconductor layer structure including a Bragg mirror portion and a gain portion. An external mirror and the Bragg-mirror portion define a laser resonant-cavity including the gain-portion of the semiconductor layer structure. A birefringent filter is located in the resonant-cavity for selecting a frequency of the laser-radiation within a gain bandwidth characteristic of semiconductor structure. An optically-nonlinear crystal is located in the resonant-cavity between the birefringent filter and the external mirror and arranged to double the selected frequency of laser-radiation.

as the radiation generating quantum well structure (16). Kinoshita teaches the pump radiation source (30) being on the common substrate (1) as the radiation generating quantum well structure (10) for the advantageous benefit of providing

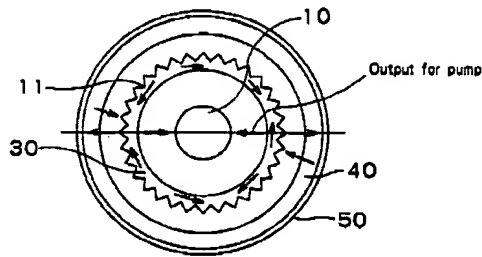


FIG. 1 A

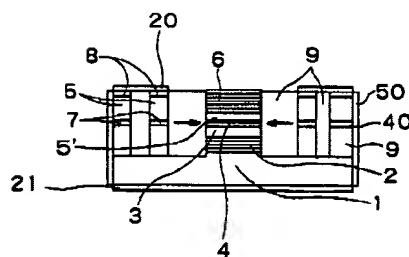


FIG. 1 B

high performance, optically pumped, surface emitting type of light emitting element that can also be manufactured extremely efficiently (see col. 2 lines 10-14).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the pump radiation source being on the common substrate as the radiation generating quantum well structure, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Furthermore, it would have been obvious to one of ordinary skill to modify Caprara et al by having the pump radiation source being on the common substrate as the radiation generating quantum well structure, as taught by Kinoshita, for the

advantageous benefit of providing high performance, optically pumped, surface emitting type of light emitting element that can also be manufactured extremely efficiently.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quyen P. Leung whose telephone number is (571)272-1943. The examiner can normally be reached on 8-4:30, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minsun Harvey can be reached on (571)272-1835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Quyen P. Leung  
Primary Examiner  
Art Unit 2828

QPL